IN THE

# SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, A. D. 1916.

THOMAS EWING, COMMISSIONER OF PATENTS,
*Petitioner,*
vs.
UNITED STATES, ex rel. THE FOWLER CAR COMPANY,
*Respondent.*

Petition for Writ of Certiorari to the Court of Appeals for the District of Columbia.

## BRIEF FOR RESPONDENT.

The petition herein does not correctly state the question involved. The real question involved in this proceeding is, "May the Commissioner of Patents refuse to declare an interference between copending applications for patents where he has determined that one exists, on the ground that it is unnecessary, in his judgment, because he has learned that the date of conception of the invention alleged by the party last to file is later than the assumed effective filing date of the other party."

The petition presents the question as though the application for the writ of mandamus sought to control the

action of the Commissioner upon a question which was committed to his determination; in other words, the petition represents that an effort is being made to control the *opinion* of the Commissioner concerning matters which are referred to his judgment.

The statement of facts contained in the petition is correct as far as it goes, but it omits material matters.

## Statement of Facts.

The Commissioner on November 18, 1915, under a practice long followed in the Patent Office, suggested certain claims to the applicant Fowler. The purpose of such a suggestion is to enable the applicant to include the suggested claims in his own application if he desires an interference with another applicant. In the same letter the Commissioner requested Fowler to furnish a statement as to his dates of invention. This statement is not provided for in the Rules of Practice; its requirement is an innovation established by the present Commissioner; it is without warrant of law or authority of any sort under the statute or the rules; is irregular in character, in that the statement is not made a part of the files, but is returned to the applicant, and the furnishing of such a statement cannot be enforced and no penalty can be attached lawfully to a failure to furnish such statement.

The applicant Fowler furnished this informal statement and in connection therewith filed an amendment to his application in regular form including the claims suggested. Fowler's amendment was received and filed on November 26, 1915 (Petition, page 3). This of course made these claims a part of Fowler's case and established that there was an interference in fact, because the

notice to Fowler by the Commissioner said: "There is another application pending, claiming substantially the same invention as that defined in the following claims." Fowler requested that if such claims did appear in a co-pending application, an interference be declared. The Commissioner thereupon refused to declare the interference, basing his refusal on the ground that Fowler's dates of invention as set forth in the irregular statement furnished by Fowler were some months subsequent to the filing date of the application of the other party.

Upon this refusal to declare the interference, the petition for mandamus was filed.

The petition for the writ of certiorari states (page 7) that Rules 93 to 132 point out the method by which interferences are determined, but the petition refers to only three of these rules. One of the rules, not set out in the petition, provides for certain motions and for decisions thereon. This rule is numbered 122 and is printed below.* Under this rule, which was promul-

*122. Motions to dissolve an interference (1) alleging that there has been such informality in declaring the same as will preclude the proper determination of the question of priority of invention, or (2) denying the patentability of an applicant's claim, or (3) denying his right to make the claim, should contain a full statement of the grounds relied upon and should, if possible, be made not later than the thirtieth day after the statements of the parties have been received and approved. Such motions and all motions of a similar character if in the opinion of the Commissioner they be in proper form, will be heard and determined by the law examiner, due notice of the day of hearing being given by the Office to all parties. If in the opinion of the Commissioner the motion be not in proper form, or if it be not brought within the time specified and no satisfactory reason be given for the delay, it will not be considered, and the parties will be so notified.

When the motion has been decided by the law examiner the files and papers, with his decision, will be sent at once to the docket clerk.

Motions to shift the burden of proof should be made before, and will be determined by, the Examiner of Interferences. No appeal from the decision on such motions will be entertained, but the matter may be reviewed on appeal from the final decision upon the question of priority of invention.

gated more than twenty-five years ago and followed during that period by the Patent Office, the question of interference in fact, the question of seniority of the parties, the patentability of the claim to one or the other, and a number of other questions became *inter partes*, and it often happens that the interference is dissolved because of mistake in declaring it or the burden of proof shifted on the ground that the senior party is not entitled to his original filing date as his effective date for the reason that he did not disclose the invention in his case as originally filed, or that he was not entitled to make the claims, or that the junior party had an earlier filed case disclosing the invention, or that the issues as formed did not apply to the structures of the two parties.

All of these questions arise, or may arise, in every interference which is declared, and by means of these preliminary motions and the judgment of the Patent Office thereon the issues are clearly defined, the relations of the parties to each other are settled, and if no conflict in fact exists the interference is terminated. This practice prevents a judgment of record based solely upon an *ex parte* consideration by the Commissioner and affords each of the parties an opportunity to contest the right of the other party to a judgment. This practice is still followed by the present Commissioner when interferences are declared. The irregular practice here complained of was engrafted by him upon the rules, or rather established outside of the rules for the purpose, he declares, of avoiding a declaration of interferences wherein, in his opinion, the junior party could not prevail. It is this practice which Fowler complained of and which the courts below have forbidden.

The petition for mandamus set out the filing of the

application by Fowler, the assignment thereof to the Fowler Car Company, the appointment of an attorney to prosecute the application, the Commissioner's letter of November 18, 1915, calling for a statement as to Fowler's dates of invention, the response by Fowler, the amendment to Fowler's application incorporating the suggested claims, and the statute requiring the Commissioner to declare an interference.

The petition for mandamus also set out the authority for the Rules of Practice and the relevant rules which had been established, and charged that:

> "it clearly appears, and petitioner charges, the fact to be that there are now pending in the Patent Office two applications for patents, to-wit: Petitioner's said Fowler application and an application of an applicant to your petitioner unknown, which applications disclose and claim the same patentable invention, and that a case of interference exists between said applications under the statutes and rules, and that it is the duty of the respondent, under the statute and rules to declare said interference."

The petitioner further sets out that the refusal of the Commissioner to declare the interference was contrary to his duty; that the demand for a statement of Fowler's dates was irregular and unjustifiable; that the statement of the Commissioner that he would issue a patent to the unknown applicant constituted a breach and violation of the statute and of the rules; is calculated to and will seriously damage and injure the petitioner; that the conduct of the Commissioner complained of is a matter of large public concern involving the validity and binding effect of the interference rules upon the Commissioner and other officials of the Patent Office; that for over a quarter of a century the predecessors of the present Commissioner without exception regarded said interference rules as imposing

upon them the legal duty of declaring an interference whenever two pending applications claimed substantially the same patentable subject-matter; that the Commissioner's conduct complained of is a radical departure from and violation of said long settled practice; that the Commissioner has refused and continues to refuse to declare the aforesaid interference, and that the petitioner was without redress or remedy except by the writ of mandamus.

The answer of the Commissioner admits the filing of the Fowler application, the call upon Fowler for a statement of his dates of invention, Fowler's response thereto and the filing of the amendment containing the claims suggested to Fowler, and the request that an interference be declared. The answer admits that the respondent notified Fowler's attorney that the interference would not be declared. The Commissioner's answer further denied that he had violated any statute or rule of the Office, and contained *arguendo* his reasons for refusing to declare the interference. *The answer nowhere denies that an interference in fact exists.*

## I.

The statute allows no discretion to the Commissioner to declare an interference if one exists. Section 4904 provides:

> "Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application or with any unexpired patent, he shall give notice thereof to the applicants or applicant and patentee as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention."

The fact that the Commissioner had formed the

opinion that an interference existed is shown, first, by his call upon Fowler to furnish a statement, second by the suggesting of the claims to Fowler, and third by the language of the Commissioner's letter of November 18, 1915 (Exhibit "A," page 9), which concludes:

> "In order to determine whether *it is necessary to declare an interference,* you are requested to obtain a statement from Fowler," etc. (Italics ours.)

The statute, it is to be noted, is mandatory so far as the declaration of the interference is concerned. Rule 94 of the Rules of Practice in the Patent Office which was in effect until January 1, 1916, is also positive in its provisions. It says:

> "Interferences will be declared in the following cases when all the parties claim substantially the same patentable invention: 1. Between two or more original applications containing conflicting claims," etc.

In the present case there is no doubt these two applications contain conflicting claims. The Commissioner was not seeking information to enable him to form an opinion whether there was an interference, but he was seeking information which would enable him to avoid declaring an interference which existed. The Court of Appeals took this view, for its opinion says:

> "The Commissioner's return to the rule to show cause is based upon the ground that petitioner's date of conception is several months subsequent to the date on which the other application was filed and that this finding justifies the Commissioner in refusing to declare an interference. Concededly the Commissioner found that an interference existed between the pending applications, but to avoid what he deemed must in all probability result in fruitless litigation he refused to declare an interference."

The Commissioner's brief in support of his petition

(page 13) says that the Court of Appeals was in error and that no such concession was made by the Commissioner or by his counsel and that it is expressly repelled by him. Of course we are not permitted to speak except from the record, but we submit that the Commissioner's answer nowhere denies that an interference exists, and that the correspondence showed that he believed that an interference did exist, and that the filing of the amendment to Fowler's application established an interference. The discretionary power of the Commissioner does not go so far as to permit him to refuse to act where his own correspondence shows that action was required. It is not the business of the Commissioner to decide whether interferences are wise or otherwise, but simply to follow the law and the rules.

## II.

The brief for the Commissioner says:

> "If the Commissioner of Patents has knowledge that any facts exist which render impossible an interference or conflict between claims, he has a right, without more, to find that there is no interference in fact. He is not required to institute an interference proceeding to determine priority, when he is aware of facts which show that no question of priority can arise in the case." (Page 14.)

This simply means that if the Commissioner concludes that the junior party cannot prevail in the interference, he will refuse to declare it. Interference is a question of fact; it exists, or it does not exist. If it exists it must be determined in the way pointed out by the statute and the rules.

The brief for petitioner contends that the Court of Appeals confuses the meaning of the word interference as used in the statute and in the rules. As we under-

stand the opinion it clearly recognizes the right of the Commissioner to form an opinion as to whether an interference exists and as clearly declares that when the Commissioner has formed and expressed such an opinion he is obliged to declare it.

The answer to the petition for mandamus and the present petition and brief in substance amount to nothing more than an argument against the positive mandate of the statute and the rules based upon the Commissioner's views as to the propriety of the legislation.

The letter of the Commissioner to Fowler (Exhibit "A," Rec., p. 9) says:

> "There is another application pending *claiming* substantially the same invention as that defined in in the following claims." (Italics ours.)

Then follow seven claims.

Fowler immediately filed an amendment (Exhibit "C," Rec., p. 10), incorporating those claims in his application and requested an interference.

The Commissioner having thus formed and expressed an opinion that the pending application of another applicant was "claiming substantially the same invention as that defined in the following (suggested) claims" which were then made by Fowler, the provisions of the statute and of the rules applied and nothing remained for the Commissioner to do but to declare the interference.

This he refused to do and therefore the court clearly recognizing the distinction between this case and the Trussed Concrete Steel Company case ordered the Commissioner to follow the statute.

With all due respect we submit the contention of the petitioner's brief (p. 15) that the Commissioner was seeking to obtain from Fowler the information as to

the date of his conception of his invention for the express purpose of "forming an opinion" as to whether any interference existed is contradicted by his own acts.

The *fact* as to whether an interference existed was the only thing to be determined by him. The question as to which of the parties was entitled to an award of priority as to that invention could only be determined by the institution of an interference and due proceedings therein. That determination is not conditioned by any such considerations as those advanced by the petition under the heading "Reasons of public import for the issue of the writ" (pp. 8-11, Commissioner's petition and brief).

In answer to the suggestions of the Commissioner (pp. 17-18) forming, it is contended, exceptions under the statute and the rules we reply:

(*a*) There is no claim here that Fowler had abandoned his invention. On the contrary he made the interfering claims at the same time that he demanded the interference.

(*b*) There is no claim that Fowler was debarred from obtaining a patent in this country because of an earlier filed foreign application.

(*c*) The Commissioner had no knowledge from Fowler's statement that no interference in fact existed or that the senior applicant was the prior inventor, for the Commissioner had himself declared that an interference in fact existed and he sought to avoid its declaration by an *ex parte* determination that Fowler could not prevail whereas the Commissioner did not and could not *know* that fact.

Nor does the practice of the Patent Office with respect to the declaration of interferences between an application and an unexpired patent affect the present inquiry.

The reason for the rule requiring an applicant to file an antedating affidavit as a prerequisite to the declaration of an interference between his application and an unexpired patent is that such patent until overcome by an antedating affidavit is a bar to the grant of any patent to the applicant. Such patent is a public record. Its disclosure and its history are open to the applicant. He may determine its efficacy as a bar and its sufficiency as to disclosure by a comparison with his own application. He need leave nothing to the *ex parte* consideration of the Patent Office but may contest every point with full knowledge of the facts. Therefore unless he can overcome the patent as a bar he is not entitled to an interference.

But the case of two pending applications is obviously different. Here the junior applicant knows nothing concerning the facts. He is not permitted to know who his opponent is, to see his application or to know when it was filed. He must accept the mere dictum of the Patent Office as to its existence, contents and legal effect.

In the case of a patent the Office has no power to alter, modify, restrict or cancel. In the case of a pending application the Office may require the applicant to modify his claims and if he does not may reject them.

## III.

Petitioner contends (pp. 22-24 of his petition and brief) that even if the Court of Appeals was right in holding that the Commissioner had found an interference existed it should have refused the writ because it required a vain thing.

This argument is based on the assumption that when Fowler disclosed his date of invention the Commis-

sioner might institute a comparison of such dates with the mere chronology of the unknown application and say that no interference could exist. He admits (p. 22) that in such case the "senior applicant's application would go through the Patent Office in the regular course of procedure in an *ex parte proceeding*, and patent would issue to him." This is precisely what the Commissioner told Fowler in the letter (Exhibit "D," Rec., p. 11), and he further added that "the pending application when patented will be cited as a reference against such claims in Fowler's application as it may be found to anticipate."

It would be difficult to conceive of a more arbitrary or high-handed proceeding in the face of a statute and the Commissioner's own rules than this.

The only answer possible to the statement of the middle paragraph, page 23 of the brief in support of the petition, is that our position was misunderstood. We are not obliged to give reasons for asking in our client's behalf that the statute, the rules and the practice of the Patent Office be followed by the Commissioner. But lest we be further misunderstood we say now that we desire that an interference be declared in order that we may know what we have to meet; that we may have an opportunity to contest the question of priority and that the issuance of a patent to an opponent with interfering claims in an *ex parte* proceeding may be prevented.

Further to prevent misunderstanding we point out that the Commissioner had no power to deny applicant Fowler *any* right which is given him by the statute and the rules of the Patent Office.

If the right of opposition is a substantial right following and dependent upon the declaration of an interference then Fowler has the right to have the interference declared.

## IV.

The declaration of interference confers certain rights upon each of the parties, and the procedure provided in Rule 122 affords an opportunity for arranging the parties in proper order according to the true and effective dates of their respective applications whereby the burden of proof is fixed and the presumption of priority attaches. The motions allowed by this rule are not necessarily motions to destroy an interference, but they are provided in order to secure the proper alignment of the parties and to determine the order and burden of proof. In short, to prevent the issue of patents to the wrong person.

As a result of these motions it may appear—and often does appear—that the party who was the first to file was not the first to disclose the invention covered by the claims, and therefore it may and frequently does turn out that the junior party, whose dates of conception are later than the other party's filing date nevertheless prevails because the application of the senior party as originally filed may not disclose the invention. It is quite true that a party whose dates of conception are subsequent to his opponent's filing date has the burden of showing that his opponent is not entitled to his filing date but this burden can be and often is successfully borne and the junior party prevails in the contest.

Even assuming that the Commissioner after careful consideration decides that the earlier filed application discloses the invention so as to entitle such earlier applicant to his original filing date he is not warranted in refusing to declare an interference on such *ex parte* examination because under the rules of practice that is an *inter partes* question.

The fact that motions to shift the burden of proof often prevail is a sufficient answer to the present claim of the Commissioner that he is authorized to substitute his judgment for the procedure provided by his own rules.

The petitioner's brief says (p. 24) that the motions provided for by Rule 122 are a mere incident of the procedure *after* the Commissioner shall have found an interference in fact, and after the technical declaration of an interference. It is true such motions cannot be made *before* the interference is formally declared and it is also true that these motions are provided for by rule and not by statute.

But it does not follow that the Commissioner may refuse to follow the statute and thus cut off the right of the applicant to avail himself of the provisions of the rule.

The fact is that the statute and the rules taken together determine the rights of the parties and the procedure to be followed.

The power to make rules or regulations governing procedure in the Patent Office is conferred by Section 483 of the Revised Statutes, which reads as follows:

> "Sec. 483. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office."

In pursuance of this provision the Commissioner of Patents from time to time and with the approval of the Secretary of the Interior has made rules or regulations and from time to time with like approval has amended the same, the last amendment having been made during the current year.

These rules or regulations have the force and effect of law and are binding as well upon the Commissioner as upon applicants. Such rules or regulations can only be repealed or modified by the same authority that promulgated them, namely, by the Commissioner of Patents with the approval of the Secretary of the Interior.

The right of an applicant to have an interference declared between the claims of his pending application and a pending application of another party claiming the same or substantially the same patentable subject-matter has never been questioned by any former Commissioner of Patents nor by the present Commissioner until within a very recent period.

Respondent invokes the settled practice of the Patent Office in support of its position. Even if the statute and the rules were ambiguous (which is not the fact), the long-established interpretation of them by previous Commissioners should not be disturbed.

In *Allen* v. *U. S. ex rel. Lowry*, 22 App. D. C., 8, the Court of Appeals, District of Columbia, speaking through Mr. Justice Duell, said:

> "While we recognize the rule as laid down in *Houghton* v. *Payne*, 194 U. S. 88, 48 L. Ed. 888, 24 Sup. Ct. Rep. 590, and in other decisions of the Supreme Court, that, if a practice is contrary to law, it is not made lawful by the practice of a department for a long period of time, yet due regard should be given to a practice which admittedly has prevailed for more than twenty-five years in proceedings of a judicial character, even should there be a reasonable doubt in the mind of the court as to the proper construction to be placed upon a statute. The Supreme Court said, in *Bate Refrigerating Co.* v. *Sulzberger*, 157 U. S. 1, 39 L. Ed. 601, 15 Sup. Ct. Rep. 508:
>
> "'If the statute be not so explicit as to preclude construction, if, upon applying to it the

established rules of interpretation; if, looking at it in the light of previous legislation on the subject; if there be reasonable ground for adopting one of two constructions;—this court, without departing from sound principle, may well adopt that construction which is in harmony with the settled practice of the executive branch of the government."

## V.

### Mandamus a Proper Remedy.

This does not seem to be controverted by counsel for petitioner, the only suggestion being as already noted that the writ would in the opinion of the Commissioner be ineffective.

Respondent recognizes the limitations upon the power of courts to control the actions of an executive or judicial officer by mandamus. Neither discretion, when discretion is permitted, nor judicial power, when such power is conferred, can be so controlled. But where no discretion is permitted or where the exercise of judicial power is sought to be avoided or evaded, mandamus is the proper remedy.

The courts may not compel the Commissioner to declare an interference if none exists, nor say how he shall decide an interference which has been declared, but they have power to compel the declaration of an interference when interference admittedly exists, and to compel the Commissioner to proceed to a determination of the question of priority. In short, to take jurisdiction. We simply asked that the Commissioner be required to take jurisdiction and then to proceed according to law and the rules of practice.

See *Commissioner of Patents* v. *Whitely*, 4 Wall., 522.

*Ex parte Parker*, 120 U. S., 737.
*Hudson* v. *Parker*, 156 U. S., 277.
*United States ex rel. Todd* v. *Gongwer*, 37 App. D. C., 555.

It is respectfully submitted that the writ of mandamus was properly granted and that the petition for certiorari should be denied.

MELVILLE CHURCH,
CHARLES C. LINTHICUM,
*Counsel for Respondent.*

October, 1916.

White Supreme Court, U. S.
APR 16 1917
JAMES D. MAHER
Clerk

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# SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, A. D. 1916.

THOMAS EWING, COMMISSIONER OF PATENTS,
Petitioner,
vs.
UNITED STATES, ex rel. THE FOWLER CAR COMPANY,
Respondent.

No. 722.

On Writ of Certiorari to the Court of Appeals for the District of Columbia.

# BRIEF FOR RESPONDENT.

NELVILLE GRUBER,
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# SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, [illegible]

THOMAS LYNCH, COMMISSIONER OF [illegible]

No. 781.

UNITED STATES ex rel. THE HOWLAND [illegible] COMPANY.

On Writ of Certiorari to the Court of Appeals for the District of [illegible]

# BRIEF FOR RESPONDENT

[illegible]
[illegible]

# INDEX.


The question involved..... 1
Statement of facts..... 2
Argument:
Section 4904 mandatory..... 6
Interference exists regardless of relative dates of the parties..... 13
Fowler legally entitled to have interference declared..... 17
Prejudicial results of interference practice at issue..... 21
Statute gives right of opposition..... 26
Alleged injury to senior parties..... 27
What inquiry should be made?..... 28
Patent Office Rules of Practice relative to interferences..... 33
Has injury or damage to respondent been shown? 33
The long recognized construction of Section 4904 is in harmony with other sections of the patent statutes..... 35
Mandamus a proper remedy..... 39
Conclusion..... 40


CASES CITED.


Allen *v.* U. S. *ex rel.* Lowry, 22 App. D. C., 8..... 20
American Lava Co. *v.* Steward, 215 U. S., 161..... 39
Carlin *v.* Goldberg, 236 O. G., 1222..... 30
Christensen *v.* Noyes, 15 App. D. C., 94..... 29
Commissioner of Patents *v.* Whitely, 4 Wall., 522.. 40
*Ex parte* Parker, 120 U. S., 737..... 40
Hudson *v.* Parker, 156 U. S., 277..... 40
Roberts *v.* United States, 176 U. S., 221-231..... 34
United States *ex rel.* Todd *v.* Gongwer, 37 App. D. C., 555..... 40
U. S. *ex rel.* Rodriguez *v.* Bowyer, 25 App., 121... 34
Westinghouse *v.* Boyden, 170 U. S., 537..... 39

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On Writ of Certiorari to the Court of Appeals for the District of Columbia.

## BRIEF FOR RESPONDENT.

The sole question involved is the construction of U. S. Rev. Stat. 4904, which reads as follows:

> "Sec. 4904. Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the

decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty years, as the Commissioner shall prescribe."

Respondent contents, and its contention was upheld by the Supreme Court and Court of Appeals of the District of Columbia, that the construction which has uniformly been given said statute for more than twenty-five years, in fact ever since its enactment, is correct, while respondent argues that as a matter of expediency a new construction should be given to it.

## Statement of Facts.

The Commissioner on November 18, 1915, under a practice long followed in the Patent Office, suggested certain claims to the applicant Fowler. The purpose of such a suggestion is to enable the applicant to include the suggested claims in his own application if he desires an interference with another applicant. In the same letter the Commissioner requested Fowler to furnish a statement as to his dates of invention. This statement is not provided for in the Rules of Practice; its requirement is an innovation established by the present Commissioner; it is without warrant of law or authority of any sort under the statute or the rules; is irregular in character, in that the statement is not made a part of the files, but is returned to the applicant, and the furnishing of such a statement cannot be enforced and no penalty can be attached lawfully to a failure to furnish such statement.

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> "it clearly appears, and petitioner charges, the fact to be that there are now pending in the Patent Office two applications for patents, to-wit: Petitioner's said Fowler application and an application of an applicant to your petitioner unknown, which applications disclose and claim the same patentable invention, and that a case of interference exists between said applications under the statutes and rules, and that it is the duty of the respondent, under the statute and rules to declare such interference."

The petition further set out that the refusal of the Commissioner to declare the interference was contrary to his duty; that the demand for a statement of Fowler's dates was irregular and unjustifiable; that the statement of the Commissioner that he would issue a patent to the unknown applicant constituted a breach and violation of the statute and of the rules; is calculated to and will seriously damage and injure the petitioner; that the conduct of the Commissioner complained of is a matter of large public concern involving the validity and binding effect of the interference rules upon the Commissioner and other officials of the Patent Office; that for over a quarter of a century the predecessors of the present Commissioner without exception regarded said interference rules as imposing upon them the legal duty of declaring an interference whenever two pending applica-

tions claimed substantially the same patentable subject-matter; that the Commissioner's conduct complained of is a radical departure from and violation of said long-settled practice; that the Commissioner has refused and continues to refuse to declare the aforesaid interference, and that the petitioner was without redress or remedy except by the writ of mandamus.

The answer of the Commissioner admits the filing of the Fowler application, the call upon Fowler for a statement of his dates of invention, Fowler's response thereto and the filing of the amendment containing the claims suggested to Fowler, and the request that an interference be declared. The answer admits that the Commissioner notified Fowler's attorney that the interference would not be declared. The Commissioner's answer further denied that he had violated any statute or rule of the Office, and contained *arguendo* his reasons for refusing to declare the interference. *The answer nowhere denies that an interference in fact exists.*

## Section 4904 Mandatory.

The statute allows no discretion to the Commissioner to declare an interference if one exists. Section 4904 provides:

> "Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application or with any unexpired patent, he shall give notice thereof to the applicants or applicant and patentee as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention."

The Commissioner endeavors to reconcile his refusal to declare the interference with the plain requirement of the statute to do so, by taking the position that no application in his opinion can interfere with another ap-

plication unless the date of conception of the invention by the later applicant is prior to the filing date of the earlier applicant, and hence as he has ascertained that Fowler's date of conception was subsequent to the filing date of the other application, the statute does not require him to declare an interference, as in his opinion none exists. This contention, while ingenious, is unsound, as it confuses two separate and distinct questions which arise in the interference practice in the Patent Office. The first question which is presented, and which must be decided before an interference is declared, is whether or not there is in reality a conflict in patentable subject-matter between two co-pending applications. In determining this question the Commissioner is undoubtedly authorized to exercise his own judgment. When in the opinion of the Commissioner an interference does exist between two co-pending applications, then, and only then, does the question of priority of inventorship arise as between the two applicants. While the existence of an interference is a matter within the judgment of the Commissioner, yet the determination of priority as between the parties is not a matter which he is permitted to pass upon *ex parte*. The statute expressly requires that when in the opinion of the Commissioner one application interferes with a pending application or with an unexpired patent, he shall give notice thereof to the parties and "shall direct the primary examiner to proceed to determine the question of priority of invention."

If it is clear from the record that in the opinion of the Commissioner the application of Fowler interfered with another pending application, then it became his duty under the statute to give notice thereof to the parties and to "direct the Primary Examiner to proceed to de-

termine the question of priority of invention." The statute allows no discretion to the Commissioner to declare or not to declare an interference if in his opinion there is an interference of subject-matter between two co-pending applications or between a pending application and an unexpired patent.

The fact that the Commissioner had formed the opinion that an interference existed is shown, first, by his call upon Fowler to furnish a statement; second, by the suggesting of the claims to Fowler; third, by the language of the Commissioner's letter of November 18, 1915 (Exhibit "A," page 9); and fourth, by the fact that the Commissioner, since the granting of the mandamus herein, has declared interferences in those instances in which he previously wrote letters similar to that written to Fowler.

The Commissioner of Patents did not write to Fowler to ascertain his date of conception merely as a matter of idle curiosity. He obviously wrote Fowler because in his opinion Fowler's application disclosed the same invention which had already been adjudged patentable in the application of the other party, and he desired to himself decide the question of priority against Fowler should his dates be later than the filing date of the other party's application, and thereby avoid the delay incident to directing "the Primary Examiner to proceed to determine the question of priority of invention," as required by the statute.

Nor would the Commissioner have suggested the claims of the other party to Fowler had not Fowler's application, in the Commissioner's opinion, disclosed the subject-matter defined by the claims, and hence interfered with the other application. This action of the Commissioner was a clear admission on his part that the

two parties were claiming the same patentable invention.

The letter of the Hon. Commissioner of Patents of November 18, 1915, to the attorney for Fowler, referred to in the statement of the case, is found on page 9 of the Record. This letter states in the opening paragraph that the attention of the Commissioner has been called to the application of Fowler in which the person addressed was the attorney of record. The next sentence of the letter states that there is another application pending claiming substantially the same invention as that defined in the following claims. Then follows seven claims. The letter concludes:

> "In order to determine *whether it is necessary to declare an interference* you are requested to obtain a statement from Fowler setting forth when he conceived the invention defined in the above quoted claims, when he disclosed it to others and when he reduced to practice. This statement will not be made a part of the record and will be returned to you." (Italics ours.)

Considering the terms of this letter with the view to determine their meaning and effect it seems to us:

1st. That it admits an interference existed. The only question was whether it should be declared. The fact that the application of Fowler had been called to the personal attention of the Commissioner implies that the Primary Examiner had found that there was an interference.

2nd. The last paragraph of the letter is also in effect an admission that there was an interference and that the interference related to the subject-matter of the claims which were suggested to Fowler and that those claims were based or could be based upon Fowler's application. This is the only reasonable inference from the Commissioner's letter, because he asks when Fowler conceived the invention defined in the above quoted claims; when

he disclosed it to others and when he reduced to practice. This was in effect a declaration that the unknown applicant was claiming what is covered by the claims suggested; that Fowler disclosed the invention defined in said claims and the information requested was that which is covered by a preliminary statement in an interference.

There is no denial that the application of Fowler and the application of the unknown applicant contained interfering subject-matter at the date of the Commissioner's letter.

But whether or not there was at the date of that letter an interference in fact is immaterial, because Fowler in Exhibit C (Rec. 10), on May 22, 1915, filed an amendment in which the suggested claims were included, and stated as a part of the amendment.

> "It is thought that these claims appear in a co-pending application and they are inserted at this time with the request that if such claims do appear in a co-pending application an interference be declared."

Accompanying said amendment was Exhibit B, which is the statement requested from Fowler as to the dates of his invention as called for by the Commissioner's letter of November 18th. Of course it was within the power of the Commissioner when this amendment of Fowler's was received to reject the claims, but this he did not do. Therefore it must be assumed that the co-pending application contained patentable subject-matter and that this patentable subject-matter was claimed in identical terms by both parties.

All the conditions existed, therefore, which required the declaration of an interference under Section 4904.

If then we are correct in assuming that the Commissioner had already formed an opinion that there was an

interference in fact between the two applications, it is clear that Section 4904 was applicable.

Exhibit D (Rec. 11), being a letter from the Commissioner to the attorney returning Fowler's statement, says that Fowler's dates are several months subsequent to the filing date of the other party; that the other party's case would be passed to issue as soon as possible and when patented would be cited against Fowler and concludes with the statement, "An interference will not be declared."

That there was an interference at the date of his letter of November 18, 1915, is also manifest from the fact that he called upon Fowler to furnish an informal preliminary statement. No conceivable reason can exist for this demand unless the Commissioner had at the time his letter was written already formed an opinion that there was an interference between the two applications.

The Commissioner in his annual report to Congress and on page 39 of his brief states that since the mandamus was granted in this suit he has been compelled to declare 250 or 300 interferences which would never have been declared had his practice of ascertaining the dates of the junior applicants been permitted to continue. As the Commissioner would have proceeded in all such cases as he did in this case, but being unable to do so declared interferences, it is obvious that when he wrote Fowler for his dates he was not seeking information to guide him in forming an opinion as to the existence of an interference, but information to serve as a basis for refusing to declare an interference which he had already found to exist.

The statute, it is to be noted, is mandatory so far as the declaration of the interference is concerned. Rule 94 of the Rules of Practice in the Patent Office which was

in effect until January 1, 1916, is also positive in its provisions. It says:

> "Interferences will be declared in the following cases when all the parties claim substantially the same patentable invention: 1. Between two or more original applications containing conflicting claims," etc.

In the present case there is no doubt that these two applications contain conflicting claims. The Commissioner was not seeking information to enable him to form an opinion whether there was an interference, but he was seeking information which would enable him to avoid declaring an interference which existed. The Court of Appeals took this view, for its opinion says:

> "The Commissioner's return to the rule to show cause is based upon the ground that petitioner's date of conception is several months subsequent to the date on which the other application was filed and that this finding justifies the Commissioner in refusing to declare an interference. Concededly the Commissioner found that an interference existed between the pending applications, but to avoid what he deemed must in all probability result in fruitless litigation he refused to declare an interference."

The Commissioner's brief (page 21) says that the Court of Appeals was in error and that no such concession was made by the Commissioner or by his counsel and that it is expressly repelled by him. Of course we are not permitted to speak except from the record, but we submit that the Commissioner's answer nowhere denies that an interference exists, and that the correspondence showed that he believed that an interference did exist, and that the filing of the amendment to Fowler's application established an interference. The discretionary power of the Commissioner does not go so far as to permit him to refuse to act where his own correspondence and actions show that action was required. It is

not the business of the Commissioner to decide whether interferences are wise or otherwise, but simply to follow the law and the rules.

**Interference Exists Regardless of Relative Dates of the Parties.**

On page 12 of the brief for petitioner, a statement is made "if the Commissioner of Patents has knowledge that any facts exist which render it inherently impossible for two applications to interfere he has a right, without more, to find that there is no interference in fact." The foregoing statement is undoubtedly true, but is wholly inapplicable to the facts presented by the record. The facts of which the Commissioner has knowledge are as to the dates when Fowler first conceived and reduced to practice the invention, and such facts, while pertinent upon the question of priority between Fowler and the unknown applicant, have no bearing whatever upon the question whether Fowler and the unknown applicant both disclose the same patentable subject-matter.

The statement above quoted from page 12 of petitioner's brief immediately precedes the following statement:

> "He (the Commissioner) is not required to institute an interference and proceed to determine priority when he is aware of facts which show that no question of priority or actual interference can arise in the case."

The foregoing statement again confuses the two separate and distinct questions which must be determined in any interference proceeding, namely, whether an interference exists and if one does exist, which one of the parties is the prior inventor. As the facts of which the Commissioner is aware bear solely upon the question of

priority and throw no light whatever upon the existence of the conflict in subject-matter, they cannot relieve the Commissioner from his statutory duty to refer the interference which he has already found to exist to the Primary Examiner to have him determine the question of priority in accordance with the statute and Patent Office rules of practice promulgated in pursuance thereof.

Interference is a question of fact; it exists, or it does not exist. If it exists then priority must be determined in the way pointed out by the statute and the rules.

The brief for petitioner contends that the Court of Appeals confuses the meaning of the word interference as used in the statute and in the rules. As we understand the opinion it clearly recognizes the right of the Commissioner to form an opinion as to whether an interference exists and as clearly declares that when the Commissioner has formed and expressed such an opinion he is obliged to declare it.

The answer to the petition for mandamus and the petition's brief in substance amount to nothing more than an argument against the positive mandate of the statute and the rules, based upon the Commissioner's views as to the propriety of the legislation.

The letter of the Commissioner to Fowler (Exhibit "A," Rec., p. 9) says:

> "There is another application pending *claiming* substantially the same invention as that defined in the following claims." (Italics ours.)

Then follow seven claims.

Fowler immediately filed an amendment (Exhibit "C," Rec., p. 10), incorporating those claims in his application and requested an interference.

The Commissioner having thus formed and expressed an opinion that the pending application of another applicant was "claiming substantially the same invention

as that defined in the following (suggested) claims" which were then made by Fowler, the provisions of the statute and of the rules applied and nothing remained for the Commissioner to do but to "direct the Primary Examiner to proceed to determine the question of priority of invention."

This he refused to do, and therefore the court clearly recognizing the distinction between this case and the Trussed Concrete Steel Company case (42 App. D. C., 179), ordered the Commissioner to follow the statute.

With all due respect we submit the contention of the petitioner's brief that the Commissioner was seeking to obtain from Fowler the information as to the date of his conception of his invention for the express purpose of "forming an opinion" as to whether any interference existed is contradicted by his own acts.

The *fact* as to whether an interference existed was the only thing to be determined by him. The question as to which of the parties was entitled to an award of priority as to that invention could only be determined by the institution of an interference and due proceedings therein. That determination is not conditioned by considerations of alleged expediency as advanced by the petitioner.

In answer to the suggestions of the Commissioner (pp. 18-19) forming, it is contended, exceptions under the statute and the rules we reply:

(*a*) There is no claim here that Fowler had abandoned his invention. On the contrary he made the interfering claims at the same time that he demanded the interference.

(*b*) There is no claim that Fowler was debarred from obtaining a patent in this country because of an earlier filed foreign application.

(*c*) The Commissioner had no knowledge from Fow-

ler's statement that no interference in fact existed or that the senior applicant was the prior inventor, for the Commissioner had himself declared that an interference in fact existed and he sought to avoid its declaration by an *ex parte* determination that Fowler could not prevail whereas the Commissioner did not and could not *know* that fact.

Nor does the practice of the Patent Office with respect to the declaration of interferences between an application and an unexpired patent affect the present inquiry.

The reason for the rule requiring an applicant to file an antedating affidavit as a prerequisite to the declaration of an interference between his application and an unexpired patent is that such patent until overcome by an antedating affidavit is a bar to the grant of any patent to the applicant. Such patent is a public record. Its disclosure and its history are open to the applicant. He may determine its efficacy as a bar and its sufficiency as to disclosure by a comparison with his own application. He need leave nothing to the *ex parte* consideration of the Patent Office, but may contest every point with full knowledge of the facts. Therefore unless he can overcome the patent as a bar he is not entitled to an interference.

But the case of two pending applications is obviously different. Here the junior applicant knows nothing concerning the facts. He is not permitted to know who his opponent is, to see his application or to know when it was filed. He must accept the mere dictum of the Patent Office as to its existence, contents and legal effect.

In the case of a patent the Office has no power to alter, modify, restrict or cancel. In the case of a pending application the Office may require the applicant to modify his claims and if he does not may reject them.

**Fowler Legally Entitled to Have Interference Declared.**

Petitioner contends that even if the Court of Appeals was right in holding that the Commissioner had found an interference existed it should have refused the writ because it required a vain thing.

This argument is based on the assumption that when Fowler disclosed his date of invention the Commissioner might institute a comparison of such dates with the mere chronology of the unknown application and say that no interference could exist. He admits that in such case the senior applicant's application would go through the Patent Office in the regular course of procedure in an *ex parte proceeding,* and patent would issue to him. This is precisely what the Commissioner told Fowler in the letter (Exhibit "D," Rec., p. 11), and he further added that "the pending application when patented will be cited as a reference against such claims in Fowler's application as it may be found to anticipate."

It would be difficult to conceive of a more arbitrary or high-handed proceeding in the face of a statute and the Commissioner's own rules than this.

The only answer possible to the statement on pages 42-43 of the brief for petitioner, is that our position was misunderstood. We are not obliged to give reasons for asking in our client's behalf that the statute, the rules and the practice of the Patent Office be followed by the Commissioner. But lest we be further misunderstood we say now that we desire that an interference be declared in order that we may know what we have to meet; that we may have an opportunity to contest the question of priority and that the issuance of a patent to an opponent with interfering claims in an *ex parte* proceeding may be prevented.

Further to prevent misunderstanding we point out that the Commissioner had no power to deny applicant Fowler *any* right which is given him by the statute and the rules of the Patent Office.

If the right of opposition given by Rule 122 is a substantial right following and dependent upon the declaration of an interference, then Fowler has the right to have the interference declared.

The declaration of interference confers certain rights upon each of the parties, and the procedure provided in Rule 122 affords an opportunity for arranging the parties in proper order according to the true and effective dates of their respective applications whereby the burden of proof is fixed and the presumption of priority attaches. The motions allowed by this rule are not necessarily motions to destroy an interference, but they are provided in order to secure the proper alignment of the parties and to determine the order and burden of proof. In short, to prevent the issue of patents to the wrong person.

As a result of these motions it may appear—and often does appear—that the party who was the first to file was not the first to disclose the invention covered by the claims, or disclosed it in inoperative form, and therefore it may and frequently does turn out that the junior party, whose dates of conception are later than the other party's filing date nevertheless prevails because the application of the senior party as originally filed may not disclose the invention, or may disclose it in inoperative form. It is quite true that a party whose dates of conception are subsequent to his opponent's filing date has the burden of showing that his opponent is not entitled to his filing date, but this burden can be and often is successfully borne and the junior party prevails in the contest.

Even assuming that the Commissioner after careful consideration decides that the earlier filed application discloses the invention so as to entitle such earlier applicant to his original filing date, he is not warranted in refusing to declare an interference on such *ex parte* examination because under the rules of practice that is an *inter partes* question.

The fact that motions to shift the burden of proof often prevail is a sufficient answer to the present claim of the Commissioner that he is authorized to substitute his judgment for the procedure provided by his own rules.

The petitioner contends that the motions provided for by Rule 122 are a mere incident of the procedure *after* the Commissioner shall have found an interference in fact, and after the technical declaration of an interference. It is true such motions cannot be made *before* the interference is formally declared and it is also true that these motions are provided for by rule and not by statute.

But it does not follow that the Commissioner may refuse to follow the statute and thus cut off the right of the applicant to avail himself of the provisions of the rule.

The fact is that the statute and the rules taken together determine the rights of the parties and the procedure to be followed.

The power to make rules of regulations governing procedure in the Patent Office is conferred by Section 483 of the Revised Statutes, which reads as follows:

> "Sec. 483. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office."

In pursuance of this provision the Commissioner of Patents from time to time and with the approval of the Secretary of the Interior has made rules or regulations, and from time to time with like approval has amended the same, the last amendment having been made during the current year.

These rules or regulations have the force and effect of law and are binding as well upon the Commissioner as upon applicants. Such rules or regulations can only be repealed or modified by the same authority that promulgated them, namely, by the Commissioner of Patents with the approval of the Secretary of the Interior.

The right of an applicant to have an interference declared between the claims of his pending application and a pending application of another party claiming the same or substantially the same patentable subject-matter has never been questioned by any former Commissioner of Patents nor by the present Commissioner until within a very recent period.

Respondent invokes the settled practice of the Patent Office in support of its position. Even if the statute and the rules were ambiguous (which is not the fact), the long-established interpretation of them by previous Commissioner should not be disturbed.

In *Allen* v. *U. S., ex rel. Lowry*, 22 App. D. C., 8, the Court of Appeals, District of Columbia, speaking through Mr. Justice Duell, said:

> "While we recognize the rule as laid down in *Houghton* v. *Payne*, 194 U. S. 88, 48 L. Ed. 888, 24 Sup. Ct. Rep. 590, and in other decisions of the Supreme Court, that, if a practice is contrary to law, it is not made lawful by the practice of a department for a long period of time, yet due regard should be given to a practice which admittedly has prevailed for more than twenty-five years in pro-

ceedings of a judicial character, even should there be a reasonable doubt in the mind of the court as to the proper construction to be placed upon a statute. The Supreme Court said, in *Bate Refrigerating Co.* v. *Sulzberger,* 157 U. S. 1, 39 L. Ed. 601, 15 Sup. Ct. Rep. 508:

> "'If a statute be not so explicit as to preclude construction, if, upon applying to it the established rules of interpretation; if, looking at it in the light of previous legislation on the subject; if there be reasonable ground for adopting one of two constructions;—this court, without departing from sound principle, may well adopt that construction which is in harmony with the settled practice of the executive branch of the government.'"

**Prejudicial Results of Interference Practice at Issue.**

In order to determine the precise meaning of the words of the statute and the attempted justification thereunder of the practice followed in this case it may be well to remind the court that the interference practice has not at all times been uniform. Interferences were and still are frequently declared between applications which do not contain identical claims. At one period it was not the practice to suggest claims contained in one party's application to another applicant. At a later period and at the present time this is done. During the former period claims were seldom identical in terms. During the later period and at different periods in the history of the Patent Office identical claims were present because of suggestion by the Office to each of the parties, but during the whole period it has been the practice of the Office to define the subject-matter of the interference in a number of distinct issues to which the claims of the parties must substantially correspond. This practice of course is in harmony with

the statute. It permits the Commissioner of Patents to declare interferences between claims covering substantially the same patentable subject-matter although not in identical terms. It also permits or at least it does not forbid the Commissioner to suggest claims to the parties and thereby bring about identity of language between the claims of the parties, some of which may be adopted as the issues of the interference. In fact in some cases the Examiner in effect defines the invention for both parties by suggesting claims which become the issues of the interference. A moment's reflection will show that at all times therefore in the history of the Office there was room for the exercise of the Commissioner's discretion and the formation of an opinion as to whether or not an interference existed.

But this stage was passed in this case when the Commissioner suggested to Fowler claims from another application which Fowler adopted and upon which he demanded an interference. There was no room for opinion, inquiry, investigation or the exercise of discretion from that time on. Under that state of affairs the statute became immediately applicable and its language mandatory. The Commissioner had formed the opinion that an interference existed; the filing of the identical claims by Fowler made that interference an actual fact, and the only thing left to be done was to follow the statute and formally declare the interference.

The statute is to be construed with reference not alone to the business of the Office but with reference to the rights of applicants before the Office. It is not denied that the Patent Office is a great business institution; so is the Post Office; so are the courts, the Internal Revenue Department, and the various other branches and departments of the Government. The

function of the Patent Office is to examine applications for patents and to grant patents to the original and first inventor. It was never intended that the Patent Office should grant patents to anybody else except the original and first inventor. Neither the Federal Constitution nor the statutes made in pursuance thereof authorizes the grant of patents to anybody but the first inventor. The work of the Patent Office therefore divides into two general classes:

1st. To examine pending applications to ascertain whether the thing claimed is patentable; and,

2nd. To determine as between two parties claiming the same invention which one is the prior inventor and entitled to the patent.

It is not within the province of the Commissioner of Patents to judge without a hearing that one applicant is entitled to a patent rather than another. The Commissioner can only determine the question of priority by the medium of an interference.

The 67,000 applications referred to in the answer to the petition for mandamus as constituting the annual business of the Office are furnished to the Office for examination by inventors of the country who are represented by attorneys and solicitors practicing before the Patent Office. It may be assumed that these inventors and the attorneys are as well informed concerning their own rights and as zealous to protect them as the Commissioner of Patents is to expedite the business of his office. It is said that a large number of these applications are found to contain conflicting claims and that it is of the highest public interest that the prosecution of all applications be brought to a speedy conclusion so that patents may be issued on those which are found to be allowable. Granting all this, what has it to do with the question whether a

patent shall be granted to A for the invention of B? The speediest way to bring the prosecution of applications to a conclusion would be to issue patents in accordance with the dates of their application; in short, to abolish the interference practice, and this reform has been suggested by a great many well informed patent lawyers. But it is not the law. The law as it stands is that patents shall be granted to the original and first inventor, and the interference system is a fixed part of the law, and cannot be ignored either by the Patent Office or by the lawyers.

It is further said in the answer that only in a small percentage of cases does a later applicant succeed in establishing that he is the first inventor, where the dates are a year apart. Surely that is no reason why the small percentage of later applicants should be denied their rights.

It is pointed out that the business of the Patent Office ran behind during three years at the rate of four thousand applications a year. This might very well be brought to the attention of Congress, but we fail to see where it has any application to the question before this court.

It is also pointed out by the Commissioner that the expense and delay to applicants caused by interferences has occasioned injury and ground for well founded complaint. We have nothing to do with the management of the Patent Office and cannot see that this fact has any bearing upon the question at issue. It is further pointed out that successive interferences may be brought about and that the value of his invention may be lost to the rightful owner. It may be suggested in answer that the failure to declare an interference where one exists may produce a like result. To digress a moment, it may be

pointed out that there is no requirement that the Commissioner of Patents shall suggest claims to applicants. This practice has grown up until now it may be said that in a vast majority of the cases interferences are brought about by the Patent Office rather than by the applicants themselves. It is not intended here to criticise this practice, which was not established under the present Commissioner, but it is only mentioned to show that it is the practice of the Office and not the actions of the applicants which bring about the majority of the interferences declared. With the accumulation of business in the Office we have nothing to do, but we may call the attention of the court to the fact which we shall illustrate later that many of these old applications are kept in the Patent Office purposely to catch or entrap later applicants who are developing the arts.

The brief for petitioner outlines the organized scheme of the Commissioner to accelerate the progress of applications through the Office. The present Commissioner has inaugurated many salutary reforms, but in that particular part of the general scheme which is here in question we think he had exceeded his power and is acting in direct conflict with the statute and with the rules of practice of the Patent Office.

The statute says that when an interference exists the Commissioner shall so declare and then points out what he shall do, namely, direct the Primary Examiner to proceed to determine the question of priority of invention. The mode of determining this question is pointed out in the rules by which applicants and the Commissioner are alike bound.

**Statute Gives the Right of Opposition.**

The brief for petitioner says it does not. Whether the statute gives a right of opposition in the sense in which the expression is used in the brief is perhaps immaterial, but in the broad sense there is no question that it does give the right of opposition. The statute says that when an interference exists it shall be declared and that the Primary Examiner shall then proceed to determine the question of priority. Clearly, then, there is a fundamental and basic right of opposition on the part of any applicant, whether junior or senior, to prevent the wrongful grant of a patent to his opponent. The rules of practice not only provide for this by the declaration of an interference and point out the mode in which it shall be conducted, but they go farther and provide for certain proceedings which are strictly in the nature of opposition. Thus the rules provide that any party to an interference may within a certain limit of time bring a motion to dissolve and this may be on various grounds, *e. g.*, that the opponent has no right to make the claim; that the issue is unpatentable; that the issues do not mean the same thing when applied to the cases of the two parties, or that there has been irregularity in declaring the interference. Aside from this, motions are made which seek to shift the burden of proof and these various motions are frequently sustained and interferences are dissolved and patents refused as a result thereof.

It requires no construction of the statute to show that the right of opposition exists; that it is a valuable right; that it is recognized by the Rules of Practice and has heretofore been allowed and it requires no argument to show that the practice here complained of would utterly destroy that right.

The right of opposition is not only expressly given by Rule 122, heretofore considered, but by Rule 124, which reads in part as follows:

> "Where, on motion for dissolution, the law examiner renders an adverse decision upon the merits of a party's case, as when he holds that the issue is not patentable or that a party has no right to make a claim, he shall fix a limit of appeal not less than twenty days from the date of his decision. Appeal lies to the examiners in chief in the first instance and will be heard *inter partes.*"

## Alleged Injury to Senior Parties.

In petitioner's brief the right of the senior party to obtain his patent without opposition is weighed against the right of the junior party to oppose, and illustrations are given as to what might happen because of following the plain language of the statute and of the Rules of Practice. If illustrations are in order perhaps we may be able to give one which will illustrate a class of actual cases within the knowledge of the Commissioner of Patents and of every practitioner before the Office.

An application is filed for a patent by a professional inventor or by some one who is following an art with a view to speculation containing indefinite description and nebulous claims. Under the rules of the Office such an application may by amendment be kept in the Office for a number of years. Several years after the filing of such application another applicant who has developed a machine, improved a process, or advanced an art, comes into the Office with a clean-cut, properly-drawn application covering a distinct improvement in the art. Under the present practice the Patent Office, comparing the two applications, discovers that it is possible to read upon or out of the earlier-filed application the invention which

the later applicant seeks to patent, and thereupon it suggests to the earlier applicant the claims of the later. Under the practice here in question the Commissioner would inquire of the later applicant when he conceived his invention and would probably learn that the later applicant could not allege a date of conception earlier than the filed application. Thereupon he would refuse to declare an interference and the senior applicant would have handed to him claims which he never thought of making for an invention which he did not conceive and which could only be spelled out of his application by the aid of the more precise and specific disclosure of the second applicant.

This is no fanciful case because it has occurred many times in the Patent Office.

Now, whose interest would be sacrificed in such case if the present practice had not been adopted? Clearly not that of the first applicant. If he was in a hurry he could have had his patent long before, but he does not wish it to come out. He has set his eel trap in the Patent Office and he catches many eels as they come down the stream.

## What Inquiry Should Be Made?

In petitioner's brief it is asserted that if the later applicant does not claim a date of invention prior to the date upon which the earlier application was filed, there is no question of priority and therefore no ground for instituting the interference, and reference is made to the practice with relation to granted patents. Let us see whether this argument is sound. In arranging the parties to an interference it is the practice to consider the dates of the applications, the earlier to file being considered the senior party and the junior party having the burden of proof on the question of priority. It fre-

quently happens that an interference is declared, the parties being thus arranged in the order of their dates of application, and it turns out that the senior applicant did not disclose the invention in question in his application as originally filed. It often turns out, also, that the junior applicant, when the files of his opponent's case are opened for inspection and the matter is thoroughly understood, is able to show that he (the junior applicant) had a still earlier filed application which disclosed the subject-matter, and motion is made to shift the burden of proof. Again, it sometimes happens that the date of application accorded the senior applicant is not his true date under the law.

From the report of *Christensen* v. *Noyes*, 15 App. D. C., 94, it appears that Noyes filed an application in the Patent Office May 13, 1895, which was allowed November 26, 1896, became forfeited for nonpayment of fee and was not renewed till June 28, 1897.

Christensen filed his application April 30, 1896. The Commissioner held that Noyes was entitled to consider May 13, 1895, the filing date of his forfeited case, as his effective date of application, but such holding was reversed by the court on the ground that Noyes' effective date was the date of the filing of the renewed application of June 28, 1897, and not that of his first forfeited application.

We of course do not know what the facts are in the case at bar, or by what course of reasoning the Commissioner has arrived at the date of application of the unnamed applicant, but it is at least conceivable that the Commissioner has given the undisclosed interfering applicant the benefit of a filing date to which in law he is not entitled, just as his predecessor did in the Noyes case. On the declaration of an interference such error

could be corrected and justice done and the rights of the petitioner preserved.

It also not infrequently occurs that on motions to dissolve interferences it develops that one of the parties discloses an inoperative structure in his application and hence, no matter how long he filed his application before that of his opponent, he is not entitled to be awarded priority of invention. Numerous published decisions disclose such a situation. A recent instance is found in *Carlin* v. *Goldberg*, 236 O. G., 1222. It may be that the other application referred to by the Commissioner in his letters to Fowler discloses an inoperative structure, and hence Fowler may for that reason be entitled to an award of priority, notwithstanding his later date of conception.

All of these questions may be raised on motions to dissolve and to shift the burden of proof under the Rules as applied before the adoption of the practice complained of. And it often happens that after an interference was formally declared it was found that the position of the parties must be reversed; or that the interference must be dissolved because the subject-matter of the interference was unpatentable; or because there was no interference in fact; or because the Examiner had made a mistake in deciding that the issues meant the same thing when applied to the cases of two parties. All of these safeguards against the issuance of a patent to the wrong party are utterly swept aside by the present practice.

It was stated by petition that over three hundred cases were disposed of during one year under the practice in question. In our view this simply shows that in three hundred instances the Commissioner has exceeded his authority and violated the rules of the Office. No mention was made, however, of the number of interfer-

ences that were disposed of after declaration and without the taking of proof in one of the ways pointed out above. In the annual report of the Commissioner to Congress he states that motions for dissolution of 241 interferences were heard during 1916, of which 57 were granted entirely and 44 in part and that ten other interferences were dissolved because the subjected matter was found unpatentable to anyone. A large number of interferences are thus disposed of upon motion by the aid of the parties themselves and with due regard to the rights of both applicants. Furthermore, a large number of these interferences are disposed of on the initiative of the junior applicant, and the issuance of many invalid patents is prevented by turning the search-light of investigation upon the rights of the senior applicant while in this stage. We do not mean to imply, of course, that the Commissioner does not inquire into the question of interference in fact, nor into the various other questions suggested before demanding a statement from a junior applicant under his present practice. What we do say is, that this investigation has always been made—perhaps not with the same care as under the present Commissioner—but the law has always required that the Commissioner should investigate and that he should decide whether an interference existed, and as to the alignment of the parties to the interference, thereby fixing the burden of proof, etc., and that notwithstanding such examination and determination by the Commissioner, it has turned out, in innumerable cases—and still does occur—that the Office was mistaken in its determination and is obliged to correct the mistake by dissolving interferences or rearranging the parties.

There are, as we have previously shown, abundant reasons for declaring an interference even if the nomi-

nal dates of the applications be far apart. The point which petitioner's brief overlooks is that neither the relative dates of the applications nor the fact that the junior party admits a date of conception later than the nominal date of an unknown applicant is controlling. The Commissioner substitutes his own judgment as to the expediency of declaring an interference for an *inter partes* inquiry as to the matter. The law gives the parties a right to be heard. The new practice denies that right. It is the purpose of this proceeding to determine whether or not the Commissioner has that power.

In short, it is not the business of the Commissioner to sit in judgment as to whether it is wise or otherwise to declare an interference.

Petitioner urges that there is here no question of overlapping dates, and that it was the deliberately formed opinion of the Commissioner that no question of insufficient disclosure arises as to the earlier dated application. But that is quite beside the point. The law and the Rules of Practice provide that the parties shall have an opportunity to raise these questions. To refuse to declare an interference is to deny that opportunity. Call it opposition or what you will, the plain right exists.

We state here most emphatically and from long personal experience that the number of instances in which the *ex parte* action of the Office in aligning parties and in determining the metes and bounds of issues has been corrected justifies us in the contention that this right of applicant's is substantial, that the judgment of the Office is often at fault and that the errors of first decision require correction and are often corrected by the officials of the Office and by the court as a result of the proceedings provided by the statute and the Rules.

**Patent Office Rules of Practice Relative to Interferences.**

It is argued by petitioner that Rule 93 justifies the action of the Commissioner. This is founded on the wording of the rule defining an interference as a proceeding instituted for the purpose of determining the question of priority, but this definition cannot be given such a narrow or illiberal interpretation as to exclude the operation of the other rules relating to the conduct of interferences, nor to exclude from consideration all other questions save the sole question of priority. Indeed, the question of priority involves many considerations, and the purpose of the statute and of the Rules is to make certain that the Patent Office shall grant patents only to the original and first inventor. The whole scheme and purpose of the interference legislation is to this end that patents shall not be improvidently granted and the public vexed by unlawful claims. The right of a junior applicant to contest an interference is as important in one aspect as in another, and any denial of that right vitiates the entire scheme and purpose of the law.

Of course Rule 93, and every other Rule of Practice, must conform to the statute, and if out of harmony therewith the rule and not the statute must yield. We see no conflict. The rule was meant to carry out the plain meaning and intent of the statute and must be so construed.

**Has Injury or Damage Been Shown?**

Petitioner has suggested that respondent has shown no damage and therefore is not entitled to the writ. It seems to us that but little argument is required to show that the right to obtain a patent, or the right to prevent

another from unlawfully obtaining a patent, is substantial, and its deprivation an injury.

If petitioner has a right to the declaration of an interference he is not to be denied because he cannot state in dollars and cents what his damage would be. It would be as idle to inquire as to that matter as it would to attempt to assign a monetary value to the right to vote or obtain a marriage license.

See:

*U. S., ex rel. Rodriguez*, v. *Bowyer*, 25 App., 121.

*Roberts* v. *United States*, 176 U. S., 221-231.

Petitioner suggests here that Fowler will not be damaged even if the unknown applicant be given a patent without a declaration of interference, and points out that Fowler may contest the validity of such patent in the courts. If he is entitled to contest it here, why is not that right a substantial and valuable one and the denial of that right a legal injury or damage? A moment's reflection will show that the right to contest the question of priority is of greater value than the right to defend a suit for infringement. It does not follow that any suit for infringement will ever be brought against Fowler or his assignee or his or their vendees. It is quite sufficient to notify a railroad company of the ownership of a patent relating to cars to prevent sales of the improvement by others. The right of the junior applicant may be entirely destroyed by the improvident issue of a patent covering his invention either broadly or narrowly, and he has no remedy because suit for infringement is not brought for the simple reason that he does not get a chance to sell his goods.

It is also suggested that respondent will not be damaged because he has a right to demand an interference with the patent to be granted to the unknown applicant. This is not a fair argument because he cannot

contest on equally favorable conditions. The burden is greater, for the issuance of the patent carries with it the presumption of validity and priority.

Petitioner's brief says that since Fowler has alleged a date of invention subsequent to the date upon which the unknown application was filed, there would be no basis for a holding that he was the first inventor. Of course this is wrong. Very frequently it happens that a junior applicant alleges a date of conception later than the nominal or claimed date of the other party and still wins the interference, and this might be true in a case under Section 4918. It is certainly true while the applications are still pending in the Patent Office.

**The Long Recognized Construction of Section 4904 is in Harmony with Other Sections of the Patent Statutes.**

The interpretation which has always been placed upon Section 4904, and which the present Commissioner seeks to have changed, is in harmony with the spirit and intent of the entire Patent Act. The underlying principle of the United States patent law is that patents shall only be granted to those who have complied with certain conditions precedent, and the Commissioner of Patents is empowered to investigate each application to determine whether or not such conditions have been complied with. The conditions upon which a person may obtain a patent are set forth in Sec. 4886 U. S. Rev. Stat., which reads as follows:

> "Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his in-

> vention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. . . ."

In order that the Commissioner of Patents may investigate each application to determine whether the applicant is entitled to a patent by his compliance with all of the conditions recited in the above-quoted section of the statute, a large examining corps is provided whose duty it is to make searches through prior United States and foreign patents and publications. This is covered by Sec. 4983, which reads as follows:

> "On the filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor."

In order to facilitate the investigation as to the novelty of the invention covered by each application a scientific library is provided. A classification division exists to so arrange and classify patents and publications as to render them most conveniently accessible.

As the question whether or not the invention covered by an application has been in public use or on sale more than two years prior to the filing of the application cannot be ascertained by an examination of prior patents and publications, a fund is provided to enable the Commissioner to conduct the necessary investigation. Sec. 4886.

Inasmuch as only one person can be the original and first inventor of an invention, the Commissioner of Pat-

ents is given the necessary authority by Sec. 4904 to institute interference proceedings to determine which of two or more applicants all claiming the same invention is in reality entitled to the patent covering the same by reason of his priority over his opponent.

For many years the Patent Office has, under the authority of Sec. 4904, utilized interference proceedings as a means to not only determine which of two or more interfering parties is entitled to a patent, but to determine whether either them should be granted a patent. This has been accomplished by means of motions brought by the parties after the declaration of an interference. This practice is not only in the interest of the applicants for patents, but also in the interest of the public, for as is frequently the case, interference proceedings develop the existence of statutory bars against the granting of patents to either of the contestants in interference and the rights of the public are thereby protected.

As previously stated, the Commissioner in his report of January 31, 1917, to Congress stated that of 241 motions for dissolution of interferences which were heard and disposed of, 111 were granted either entirely or in part, and that out of thirteen interferences in which statutory bars were discovered by the Examiner during the pendency of the interference, ten of them were dissolved.

The long-established practice in declaring interferences which the Commissioner sought to curtail therefore affords the Commissioner an otherwise unavailable avenue for investigation of the rights of applicants to patent monopolies for their claimed inventions. The Commissioner in his said report and in his brief herein laments the fact that the granting of the mandamus in this case necessitated the declaration of two hundred fifty to three hundred interferences which he could other-

wise have avoided declaring. In other words, in all of such interferences the Commissioner would have preferred to grant patents to the senior parties rather than to set in motion, through the declaration of interferences, lines of investigation which in a large number of such interferences undoubtedly lead to the development of statutory bars against one or both parties to the granting of a monopoly for the inventions involved. Had interferences not been declared in such two hundred fifty or three hundred instances, patents would have been granted to the senior parties which in many instances belonged legally to the junior parties, and in many instances rights of the public would have been prejudiced by the granting of monopolies for inventions which already belonged to the public.

The endeavors of the present Commissioner of Patents to expedite the work in his office by [illegible] as promptly as practicable after the filing of the applications therefor, is most commendable. There is, however, a more important consideration than that of expediting the granting of patents, and that is the granting of valid patents. In a large proportion of suits instituted for patent infringements, the patents in suit are held to be invalid and usually in view of prior patents or publications which were not cited in the Patent Office during the prosecution of the applications, or in view of statutory bars unknown to the Patent Office. The declaration of interferences, as conclusively proved by the report of the Commissioner, in many instances, leads to the establishment of statutory bars which were unknown to the Examiners during the *ex parte* consideration of the applications. If no interferences at all were declared it would necessarily follow that the number of invalid patents which would be granted would be greatly increased, and consequently the restriction in

the declaration of interferences, which the present Commissioner seeks to bring about by the practice in question, necessarily leads to the granting of many invalid patents, which could be avoided by following the long-established interference practice.

The granting of invalid patents is detrimental not only to the public in general, but to those industries which involve the manufacture and sale of devices dominated by such illegal monopolies. Invalid patents deprive the public of rights legally belonging to it and afford means of embarrassing manufacturers and others engaged in the industrial arts.

A comparison of relative dates of invention of two parties claiming the same invention is but one element to be considered in the question of which party is entitled to a patent. The senior party may not be entitled to his filing date as to the subject matter in controversy (*American Lava Co.* v. *Steward*, 215 U. S., 161). (3) The inventions of the two parties may be so different that they are not the same even though capable of being described by the same claims (*Westinghouse* v. *Boyden*, 170 U. S., 537). (4) Statutory bars may exist to the granting of a patent to either party.

In all of such instances the practice of the Commissioner in question would result in the granting of invalid patents to the senior parties.

## Mandamus a Proper Remedy.

This does not seem to be controverted by counsel for petitioner, the only suggestion being as already noted, that the writ would in the opinion of the Commissioner be ineffective.

Respondent recognizes the limitations upon the power

of courts to control the actions of an executive or judicial officer by mandamus. Neither discretion, when discretion is permitted, nor judicial power, when such power is conferred, can be so controlled. But where no discretion is permitted or where the exercise of judicial power is sought to be avoided or evaded, mandamus is the proper remedy.

The courts may not compel the Commissioner to declare an interference if none exists, nor say how he shall decide an interference which has been declared, but they have power to compel the declaration of an interference when interference admittedly exists, and to compel the Commissioner to "direct the Primary Examiner to proceed to a determination of the question of priority of invention." In short, to take jurisdiction. We simply asked that the Commissioner be required to take jurisdiction and then to proceed according to law and the rules of practice.

See:

*Commissioner of Patents* v. *Whitely*, 4 Wall., 522.
*Ex parte Parker*, 120 U. S., 737.
*Hudson* v. *Parker*, 156 U. S., 277.
*United States ex rel. Todd* v. *Gongwer*, 37 App. D. C., 555.

It is respectfully submitted that the writ of mandamus was properly granted and that the decree of the Court of Appeals should be affirmed.

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